

REMARKS

The Office Action dated April 30, 2008 has been received and carefully considered. In this response, claims 9-15 have been amended. No new matter has been added. Entry of the amendments to claims 9-15 is respectfully requested. Reconsideration of the current rejections in the present application is also respectfully requested based on the following remarks.¹

The outstanding rejections are as follows:

Claims 9-12 and 14-15 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pat. Pub. No. 2004/0109087 to Robinson et al. ("Robinson").

Claim 13 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of U.S. Pat. No. 6,966,066 to Zigmond et al. ("Zigmond").

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions made by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

I. THE ANTICIPATION REJECTION OF CLAIMS 9-12 and 14-15

On pages 2-4 of the Office Action, claims 9-12 and 14-15 were rejected under 35 U.S.C. § 102(e) as being anticipated by Robinson.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re King, 801 F.2d 1324, 1326 (Fed. Cir. 1986). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Celeritas Tech., Ltd., v. Rockwell Int'l Corp., 150 F.3d 1354, 1361 (Fed. Cir. 1998). "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985). Such possession is effected only if one of ordinary skill in the art could have combined the disclosure in the prior art reference with his/her own knowledge to make the claimed invention. Id.

Regarding claims 9-12 and 14-15, the Examiner asserts that Robinson discloses the claimed invention. Applicant respectfully disagrees. Specifically, Applicant respectfully submits that Robinson merely discloses a functionality generally

related to the functionality of the claimed invention. The functionality of the claimed invention, however, is carried out in a completely different manner than in Robinson.

In the claimed invention, there is no intervention in material presented to a user, a precise characterization of the broadcast material (timeline) being sent from a broadcaster to a server servicing the purchases. A user receiving a broadcast connects, at a given time, to a sale server, which precisely knows, based on the information received from the broadcaster, what material is being presented at a given time and what goods and services are related thereto, and which then presents the goods and services to the user.

In Robinson, information on goods and services is encoded directly within a visual material during a manufacture process (see Robinson page 2, paragraphs [0015] and [0017]). A special decoder at a user's side allows him/her to read out information written within a video signal and utilize it for purchasing a selected product or service (e.g., by sending the information to a WWW server).

Therefore, despite the general relation between Robinson and the claimed invention, there is a substantial difference in the respective processes:

In the claimed invention, information on goods and services is correlated only with a schedule of a broadcast received by

the user. It is a local server that decides which goods and services are correlated with the broadcast. The user only connects to a sale server during the broadcast, with the sale server showing the correlated products and services.

In Robinson, on the other hand, products and services are correlated with a broadcast at a level of a video material production process. Information written in this process is transmitted by the user to a sale server by means of a dedicated device, where the user may purchase presented goods and services.

Also, a significant difference between the claimed invention and Robinson is that in the claimed invention a service may be realized practically based on any type of broadcast (radio, TV, press, WWW, etc.) without any intervention into the broadcast and without the necessity of using any dedicated hardware at the user's side. Therefore, the sale may be realized without the necessity of cooperating with the broadcaster or producer of the broadcast.

In Robinson, an intervention is needed into the broadcast contents in order to encode information therein related to goods and services. Cooperation is necessary between the contractor and the broadcaster or the program's producer. Also, the user must have a specialized decoder allowing him/her to read out the encoded information on the goods and services and to send it to

the sale server. The process of carrying out such service is much more costly and laborious than the claimed method.

Also, in the claimed invention, the information transmitted by the user to the sale server is not the information on a product or service but rather the precise time at which the user was interested in the broadcast. In particular, as recited in claim 10, the user may store this time on any suitable device and send it to the server later. In contrast, Robinson discloses that the user sends precise information on the product or service, encoded in the television signal, to the sale server. In particular, a frame of the TV program may be frozen and the information may be read out therefrom later and then sent to the sale server, but it will still be information about a product or service rather than about the time of the broadcast. The time mentioned in Robinson is not the time of the broadcast but a relative time at which the product or service occurs within the video material. In particular, the service described in Robinson, in stark contrast to the claimed invention, may also be available based on archived materials (e.g., on a DVD disc or a VHS tape). According to the claimed invention, the service is available only based on the known time of the broadcast.

Claim 11 states that parameters (i.e., time of the broadcast) may be delivered by the user to a payment server when

establishing a connection (for example, via the USSD channel). This is contrary to Robinson, where parameters are delivered after establishing a connection (data transmission).

Claim 12 states that a portion of data on the user, necessary to carry out the transaction, is known in the system of ordering goods and services. The data may come not only from the system of ordering goods and services, but also from other systems, e.g., MSISDN number of user's phone or its geographical location in a mobile network. In contrast, Robinson (see Robinson page 3, paragraph [0029]) teaches that the sale server may know such data based on predefined parameters registered by the user. Claim 14 relates to a situation in which a user interested in an offer of goods and services delivers only a time marker to the system of ordering goods and services, by making a connection, and based on this marker the customer may (e.g., via WWW) precisely check the offer available for this marker at a later time. In contrast, Robinson, discloses that the marker is a frozen video frame which may be sent to the server at a later time. It is also a significant difference -- between a registered video frame with information on a product and a history of the user's connection to the system -- based on which information on available goods and services is generated.

At this point, Applicant would like to respectfully remind the Examiner that, as stated in MPEP § 2131, "[a] claim is

anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

In view of the foregoing, Applicant respectfully submits that the claimed invention is allowable over the cited reference, and thus respectfully requests that the aforementioned anticipation rejection of claims 9-12 and 14-15 be withdrawn.

II. THE OBVIOUSNESS REJECTION OF CLAIM 13

On pages 4-5 of the Office Action, claim 13 was rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson in view of Zigmond. This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or "secondary considerations," of non-obviousness. Graham v. John Deere Co.,

383 U.S. 1, 17-18 (1966); see also KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). An "expansive and flexible approach" should be applied when determining obviousness based on a combination of prior art references. KSR, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. Id. at 1741. Rather, there must still be some "reason that would have prompted" a person of ordinary skill in the art to combine the elements in the specific way that he or she did. Id.; In re Icon Health & Fitness, Inc., 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. KSR, 127 S. Ct. at 1740-41.

Regarding claim 13, the Examiner asserts that the claimed invention would have been obvious in view of Robinson and Zigmond. Applicant respectfully disagrees and respectfully asserts that features of claim 13 differentiate over the cited references. In particular, Applicant respectfully submits that the aforementioned obviousness rejection of claim 13 has become moot in view of the deficiencies of Robinson as discussed above with respect to independent claim 9. That is, claim 13 is dependent upon claim 9 and thus inherently incorporates all of the limitations of independent claim 9. Also, the secondary

reference, Zigmond, fails to disclose, or even suggest, the deficiencies of Robinson as discussed above with respect to independent claim 9. Indeed, the Examiner does not even assert such. Thus, the combination of Zigmond with Robinson also fails to disclose, or even suggest, the deficiencies of Robinson as discussed above with respect to independent claim 9. Accordingly, claim 13 should be allowable over the combination of Robinson and Zigmond at least by virtue of its dependency on independent claim 9.

Moreover, claim 13 recites additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claim 13 be withdrawn.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the

present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By: 

Thomas H. Anderson

Registration No. 37,063

TEA/ple/vrp

Hunton & Williams LLP
1900 K Street, N.W.
Washington, D.C. 20006-1109
Telephone: (202) 955-1500
Facsimile: (202) 778-2201

Date: 10/30/08